

Serial No. 10/701,864

Docket No. 200312367-1

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REMARKS

Claims 1-10, 12, 13, and 16-27 are currently pending in the subject application, and are presently under consideration. Claims 1-10, 12, 13, and 16-27 are rejected. Claims 1, 10, 16, 18, and 20 have been amended. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. Rejection of Claims 1-10, 12, 13 and 16-27 under 35 U.S.C. §101

Claims 1-10, 12, 13, and 16-27 are rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Office Action dated August 7, 2006, ("Office Action") states that "[t]he claims do not produce any tangible results," and that, "[f]or the result to be tangible, the computed S-parameters would need to be outputted to a user or displayed to a user or stored for later use by a user," (Office Action, page 3). Representative for Applicant respectfully submits that independent claims 1, 10, 16, 18, and 20, as well as the Specification, have been amended to recite that the S-parameters are stored in a memory. Representative for Applicant respectfully submits that the amendments to claims 1, 10, 16, 18, and 20 and to the Specification do not introduce new matter, as an S-parameter calculator can be implemented as computer executable instructions, for example, running in a computer, workstation, network analyzer or other test equipment (Present Application, page 12, ll. 9-11). Since the computation of S-parameters in such computer, workstation, network analyzer, or other test equipment inherently would result in such computed S-parameters being stored in memory, the amendments to the Specification and claims do not constitute new matter (see MPEP 2163.07(a)). Accordingly, withdrawal of the rejection of claims 1-10, 12, 13, and 16-27 under 35 U.S.C. §101 is respectfully requested.

Representative for Applicant presumes that a complete examination be performed on the Present Application. The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (www.uspto.gov/web/offices/pac/dapp/opla/preognote/guidelines101_20051026.pdf) ("Interim Guidelines") issued by the USPTO states that it is essential that patent applicants obtain a prompt yet complete examination of their applications (See Interim Guidelines, Page 3, Section II). The Interim Guidelines also state that each claim should be reviewed for compliance with every statutory requirement for patentability

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in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement (See Interim Guidelines, Page 3, Section II). The MPEP concurs with this requirement as well, stating that if a claim falls into a nonstatutory category, that should not preclude complete examination of the application for satisfaction of all other conditions of patentability (See MPEP, §2106(IV)(B)). Since no rejections have been issued in view of prior art, Representative for Applicant respectfully requests that a notice of allowance be issued.

II. Double Patenting

Claims 1-3, 5-9, and 16-27 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-10, 15, 18, 19, 21, 22, 25-27, 29, and 30 of U.S. Patent No. 6,998,833 (Wang, et al.). Nevertheless, a terminal disclaimer, in accordance with MPEP §804.02, is being submitted with this Office Action response for claims 1-3, 5-9, and 16-27 in view of claims 1-3, 5-10, 15, 18, 19, 21, 22, 25-27, 29, and 30 of Wang. Therefore, withdrawal of the rejection of claims 1-3, 5-9, and 16-27 is respectfully requested.

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III. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Should the Examiner have any questions concerning this paper, the Examiner is invited and encouraged to contact Applicant's undersigned attorney at (216) 621-2234, Ext. 106.

No additional fees should be due for this response. In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 08-2025.

Respectfully submitted,

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